

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed February 20, 2004. Claims 29-48 were pending in the Application. In the Office Action, Claims 29-48 were rejected. Claims 29-48 remain pending in the Application. Applicants respectfully request reconsideration and favorable action in this case.

In the Office Action, the following actions were taken or matters were raised:

SECTION 103 REJECTIONS

The Examiner rejected Claims 29-48 under 35 U.S.C. §103(a) as being unpatentable in view of U.S. Patent No. 6,052,669 issued to Smith et al. (hereinafter “Smith”) in view of U.S. Patent No. 6,353,824 issued to Boguraev et al. (hereinafter “Boguraev”). Applicants respectfully traverse this rejection for at least the reasons discussed below.

The Manual of Patent Examining Procedure makes clear that to establish a *prima facie* case of obviousness, three basic criteria must be met:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.

M.P.E.P. § 2143 (citing *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991)). Further, according to M.P.E.P. § 2143.01:

[T]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990)).

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. For example, Applicants respectfully submit that there is no motivation or suggestion to combine reference teachings as proposed by the Examiner, nor is there any reasonable expectation of success based on the proposed combination of references. Further, the proposed combination of references teach away from the invention as claimed by Applicants.

Independent Claim 29 is a computer-implemented ordering system reciting the following:

- an interface adapted to provide a representation of a consumer item and an option associated with the consumer item; and
- a presentation module adapted to provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option.

Smith discloses a method and system for configuring office furniture having a graphical user interface for presenting a user with various selectable options. (*Smith*, Abstract, lines 1-3, col. 3, lines 60-63). The Examiner apparently cites *Boguraev* for the purpose of disclosing an updated presentation in response to rolling a mouse over an icon, and states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of *Boguraev* with the invention of *Smith* to update the presentation when a user clicklessly positions a cursor over [an icon] because it is more efficient than requiring a user to click on an icon. (Office Action, pages 3-4). Applicants respectfully disagree.

Smith discloses a planning guide which “consists of a series of forms which are graphically displayed on the screen, each form having a number of options. Once the user selects a particular option, a screen for that option is displayed with questions about the various sub-options.” (*Smith*, col. 8, lines 12-16)(emphasis added). *Smith* also discloses that, “[f]or example, in order to determine the user’s storage requirements, the user selects a storage requirements option and is presented with a storage requirements screen.” (*Smith*, col. 8, lines 16-19)(emphasis added) Applicants respectfully direct the Examiner’s attention to Figure 8 of *Smith* illustrating a typical workstation according to *Smith* (col. 9, lines 29-34),

and Figures 10-12 of *Smith* depicting configuration screens for modifying the typical workstation (col. 9, lines 54-57, col. 10, lines 22-24, lines 29-31, col. 11, lines 8-14). As clearly illustrated in Figures 8 and 10-12 of *Smith*, the visual display of the typical workstation of *Smith* is behind or otherwise covered by the configuration screens of *Smith*. Therefore, there is no suggestion or motivation to combine reference teachings as proposed by the Examiner because the visual display of the typical workstation of *Smith* is behind or otherwise covered by the configuration screens of *Smith* from which modifications to the workstation would be selected. Thus, there is no suggestion or motivation to modify *Smith* to provide a preview representation as suggested by the Examiner because, during modification of an item by a user utilizing the *Smith* planning guide, the item being modified is not in view of the user. Clearly, the Examiner is using hindsight reconstruction to piece together the teachings of the prior art to arrive at Applicants' claimed invention, which is improper under the M.P.E.P. and the courts.

Additionally, even if there was a motivation or suggestion to combine reference teachings, which Applicants submit is lacking, there is no reasonable expectation of success based on the proposed combination of references. For example, combining reference teachings as suggested by the Examiner would not "provide a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option" as recited by independent Claim 29 because the visual display of the typical workstation of *Smith* is behind or otherwise covered by the configuration screens of *Smith*, thereby preventing a presentation of any visual update to the workstation to the user of *Smith*. Therefore, even if the teachings of *Smith* and *Boguraev* were combined, a user would not be provided with a preview representation of the consumer item by clicklessly positioning a cursor over an icon on a configuration screen of *Smith* because the modified consumer item would be behind or otherwise covered by the configuration screen of *Smith*. Therefore, there is no reasonable expectation of success to combine reference teachings as proposed by the Examiner. To the contrary, *Smith* teaches away from the proposed combination of references as suggested by the Examiner because *Smith* clearly discloses that the item being modified in *Smith* is covered or otherwise hidden from view during such modification. Therefore, *Smith* clearly teaches away from providing a user with a preview presentation of the item being modified.

Accordingly, for at least these reasons, Applicants respectfully submit that there is no suggestion or motivation to combine reference teachings as suggested by the Examiner, nor any reasonable expectation of success combining reference teachings as suggested by the Examiner. Further, the proposed combination of references teach away from the claimed invention. Therefore, Applicants respectfully submit the rejection of independent Claim 29 is improper and should be withdrawn.

Independent Claim 36 recites “providing a representation of a consumer item and an option associated with the consumer item” and “providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option.” Independent Claim 42 recites “means for providing a representation of a consumer item and an option associated with the consumer item” and “means for providing a real-time preview representation of the consumer item updated with the option in response to a user clicklessly positioning a cursor over an icon corresponding to the option.” For at least the reasons discussed above in connection with independent Claim 29, Applicants respectfully submit that the rejection of independent Claims 36 and 42 is improper and should be withdrawn because there is no suggestion or motivation to combine reference teachings as suggested by the Examiner, nor any reasonable expectation of success combining reference teachings as suggested by the Examiner, and the proposed combination of references teach away from the claimed invention.

Claims 30-35 depend from independent Claim 29, Claims 37-41 depend from independent Claim 36, and Claims 43-48 depend from independent Claim 42. Because independent Claims 29, 36 and 42 are in condition for allowance, Claims 30-35, 37-41 and 43-48 are also allowable, and Applicants respectfully request allowance of Claims 30-35, 37-41 and 43-48.

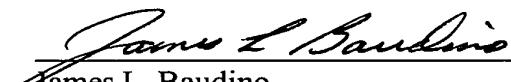
CONCLUSION

Applicants respectfully submit that Claims 29-48 are allowable over the cited art of record. Applicants have made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending claims.

No fee is believed due with this Response. If, however, Applicants have overlooked any fee due with this Response, the Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this Response to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,

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